



PATENT APPLICATION

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE
BEFORE THE BOARD OF PATENT APPEALS AND INTERFERENCES**

In re application of

Docket No: Q63733

Yoshinori MIZUMURA

Appln. No.: 09/816,774

Group Art Unit: 1764

Confirmation No.: 5498

Examiner: Ellen M. McAvoy

Filed: March 26, 2001

For: METHOD OF USING A LUBRICATING MEMBER FOR FOOD-PROCESSING
EQUIPMENT

REPLY BRIEF PURSUANT TO 37 C.F.R. § 41.41

MAIL STOP APPEAL BRIEF - PATENTS

Commissioner for Patents

P.O. Box 1450

Alexandria, VA 22313-1450

Sir:

In accordance with the provisions of 37 C.F.R. § 41.41, Appellant respectfully submits
this Reply Brief in response to the Examiner's Answer dated May 17, 2005. Entry of this Reply
Brief is respectfully requested.

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STATUS OF CLAIMS

Claims 1-7 have been rejected, and are the subject of this appeal.

GROUND OF REJECTION TO BE REVIEWED ON APPEAL

1st Ground of Rejection

The Examiner rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent No 6,119,813 to Yabe et al.

2nd Ground of Rejection

The Examiner rejected claims 1-7 under 35 U.S.C. § 103(a) as being unpatentable over published Japanese Patent Application 10-36875.

ARGUMENT

Issue 1

The Examiner's "Response to Argument" as set forth in item 10, on pages 4-6 of the Examiner's Answer, is flawed for at least the following reasons.

First, the Examiner has failed to sufficiently support her position that although Yabe does not disclose using a lubricating member at a temperature in the range from the pour point of the lubricant to not higher than 70°C, that it would operate in such a manner. In the Appeal Brief filed February 18, 2005, Applicant detailed operations of a food-processing machine at temperatures higher than 70°C (*see*, for example, the paragraph bridging pages 10 and 11). In the Examiner's Answer, the Examiner merely asserts that because both Yabe and the claimed invention are used for the same purpose, that there is a presumption that the operating temperatures of the food processing machines are the same (*see* Examiner's Answer from the last line of page 4 to the third line of page 3). However, in view of the teachings of the subject application and the references, it is improper for the Examiner to assert that there is such a presumption.

The subject application recognizes the use of lubricant members which are said to be harmless (*see* paragraph bridging pages 1 and 2 of the specification). However, the subject application also recognizes that even these lubricant members which are designed to be harmless, may have a base resin component eluted at raised operating temperatures, and that the eluted resin component can harm human beings. Therefore, the claimed invention is directed to a method of using a lubricating member at a temperature not higher than 70°C. The claimed

invention is specifically directed at a safe range of temperatures in view of the recognition of possible harm at higher temperatures. Yabe fails to recognize the possible harm at higher temperatures, and fails to disclose any particular operating temperatures. The Examiner has failed to identify a sufficient reason why one would presume that Yabe, which does not recognize the dangers of raised temperatures or discuss limiting an operating temperature in any way, should be presumed to operate at the same temperatures as the claimed invention.

The Examiner further states that “Although Yabe does not disclose the feature of using the lubricant feeder at a temperature of not higher than 70°C (185°F), it appears from the above disclosure [referring to the Yabe disclosure] that at high enough temperatures the lubricant may ooze out of the lubricant feeder and the resin component might contaminate food due to friction. However it appears that these problems occur infrequently by the use of the words in Yabe of ‘there is a possibility’. Thus the examiner is of the position that for the normal operation of food-processing machines, problems related to the high temperature of the machines do occur but not frequently.” (*see* the last paragraph of page 5 of the Examiner’s answer).

The Examiner acknowledges both that Yabe does not disclose a method of using a lubricant at a temperature of not higher than 70°C and that Yabe operates at high temperatures. The claimed invention sets forth using a lubricating member at a temperature in the range from the pour point of the lubricant to not higher than 70°C. Because the lubricant is never used at a temperature above 70°C, harm is avoided. Yabe does not limit the temperature in any way. Additionally, the Examiner acknowledges that Yabe operates at high temperatures. Therefore,

Yabe clearly does not disclose limiting the use of a lubricating member to not higher 70°C, as claimed.

Additionally, the Examiner's assertions regarding Yabe normally operating at temperatures below 70°C are unsupported. The Examiner asserts that because Yabe teaches that "there is the possibility" that lubricant oozing out of the lubricant may contaminate the foods being produced, that the Yabe food processor normally operates at below 70°C (the "possibility" language quoted by the Examiner is found in Yabe column 1, lines 44-49). The Examiner appears to believe that if Yabe normally operated above 70°C, lubricant would generally ooze out and contaminate foods being produced, rather than just possibly. Such a conclusion is simply unsupported.

There are a number of reasons that contamination described in Yabe may only be a possibility rather than a certainty. For instance, in some instances the lubricant may not ooze out because it is being blocked by structure, even though the food processor is operating above 70°C. Additionally, the food may be protected by some structure that protects it from contamination. Thus, there are a number of reasons why the food may not be contaminated even though the temperature is above 70°C. Therefore, the Examiner's reasoning is flawed and this section of Yabe does not suggest normal operating temperatures of not above 70°C.

Yabe recognizes that lubricant may ooze out and contaminate food and seeks to solve any contamination problem by using a lubricant that is believed to be harmless. The subject application recognizes that such lubricants may still be harmful at raised temperatures. Therefore, the claimed invention sets forth restricting the use of a lubricating member to between

the pour point to not higher than 70°C. Yabe discloses neither the problem associated with using a lubricating member at temperatures above 70°C nor any solution for solving the problem. Therefore, the Examiner's assertion that the claimed invention unpatentable over Yabe is incorrect and claim 1 and its dependents are allowable over Yabe.

Issue 2

Similar to the Yabe reference, the Examiner argues that that because the lubricating member in the Japanese reference (Japanese Patent Application 10-36875) may be used for the same purpose as the claimed invention, that there is a presumption that the operating temperatures of the food processing machines are the same (*see* Examiner's Answer page 6). As argued above, the subject application recognizes that there are lubricating materials which are said to be harmless, but which are not necessarily so at high temperatures (*see* paragraph bridging pages 1 and 2 of the specification), and thus teaches a method of using a lubricating member at a safe temperature range. In light of the subject application's specification of a particular range, it is inappropriate for the Examiner to presume that the prior art reference operates at the same temperatures.

The subject application specifically references JP '875, and recognizes that the JP'875 lubricating member for food processing equipment can have its base resin component eluted at raised operating temperatures. It is in light of the recognition that the lubricating member can become eluted at raised temperatures that the claimed invention sets forth a method of limiting the operating temperature. Accordingly, the claimed invention avoids using the lubricating member at raised temperatures which may be harmful. JP '875 does not recognize that the

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lubricant may be harmful at raised temperatures, and thus there is no teaching that the lubricant be used at temperatures not higher than 70°C and claim 1 is allowable over JP '875.

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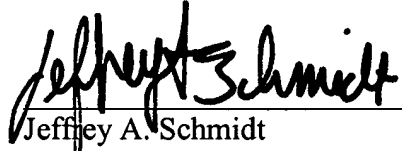
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CONCLUSION

For the above reasons as well as the reasons set forth in Appeal Brief, Appellant respectfully requests that the Board reverse the Examiner's rejections of all claims on Appeal.

An early and favorable decision on the merits of this Appeal is respectfully requested.

Respectfully submitted,


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